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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,424	06/13/2001	Catherine Rose Morrow	60001.0037US01/MS149446.1	5411

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EXAMINER

FILIPCZYK, MARCIN R

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 08/22/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,424

Applicant(s)

MORROW ET AL.

Examiner

Marc R Filipczyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

This action is in response to application filed on June 13, 2001 in which claims 1-12 are presented for examination. Information disclosure statement (IDS) submitted on 9/13/2001 is noted.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 5, 7 and 11, the phrase "edit control" is indefinite. The claimed feature has nothing to do with an editing function, thus for the benefit of continuing the examination of the application, Examiner interprets "edit control" as an input text box.

Regarding claims 2-4, 6, 8-10 and 12 depend from 1, 5, 7 and 12, use the same terminology and are therefore rejected on the merits.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term

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“edit control” in claims 1-12 are used by the claims to mean an “input text box”. The term is indefinite because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Richards et al (U.S. Patent No. 5,995,921).

Regarding claims 1 and 7, Richards discloses a method and a system for providing computer software help utility, comprising the steps of: (col. 1, lines 3-8)

Providing a text input box; (fig. 3B, item 304)

Receiving a search string at the text input box; (fig. 3B, item 306)

Searching a database for answers responsive to the search string; (fig. 3C, “Ask the Expert”)

Displaying a list of potential answers responsive to the search string; (fig. 3C, item 312)

Selecting, in response to a user input, one of the potential answers responsive to the search string; (fig. 3C, 308) and

Displaying a help text responsive to selecting one of the potential answers (fig. 3C, item 310).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richards et al (hereinafter "Richards") (U.S. Patent No. 5,995,921).

Regarding claims 1-3, 5, 7-9 and 11 Richards teaches a method and system for providing computer software help utility, comprising the steps of: (col. 1, lines 3-8)

Providing a text input box; (fig. 3B, item 304)

Receiving a search string at the text input box; (fig. 3B, item 306)

Searching a database for answers responsive to the search string; (fig. 3C, "Ask the Expert")

(Note: large data stored on computer for access and retrieval is a database)

Displaying a list of potential answers responsive to the search string; (fig. 3C, item 312)

Allowing a user to determine whether an acceptable answer is provided in the list of potential answers; (fig. 3C, item 312, *list*)

(Note: user does not have to select an answer)

Selecting, in response to a user input, one of the potential answers responsive to the search string; (fig. 3C, 308)

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Displaying a help text responsive to selecting one of the potential answers (fig. 3C, item 310).

Richards' interface is designed to enter multiple questions as many times as desired by a user (see interface fig. 3C) which may result in multiple lists of potential answers, however Richards does not expressly teach that the text input box is on the tool bar of a software application, but instead uses an interface. Examiner makes note that a tool box is part of an interface which normally executes unique functions such as executing tasks by selecting menus under file, edit, tools etc, but a software help utility function which is a search or a look up function is not typically found in most tool bars or interfaces. However, it is well known to one of ordinary skill in the art that a web-browser is a software application that allows for the browsing of the World Wide Web and that most web-browsers have a text (search) input box located in the tool bar. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement Richards' input text box on the tool bar as was done in most web-browsers by modifying the interface and displaying the input text box on the tool bar. One of ordinary skill in the art would have been motivated to have an input text box on the tool bar to allow easier user access to the input text box for software help.

Regarding claims 4, 6, 10 and 12, Richards teaches storing a search string in a list of most recently used strings (fig. 3C, *History*; also see col. 2, lines 28-37).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R Filipczyk whose telephone number is 703-305-7156.

The examiner can normally be reached on Mon-Fri, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MF

August 19, 2003



SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100